ABANDONMENT OF INVENTION

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Abandonment of invention is referred to in the Revised Statutes, directly or indirectly, in four sections, 4886, 4887, 4897, and 4920.

In section 4886, which sets forth who may obtain a patent and under what conditions, occur the reservations "not patented or described in any printed publication in this or any foreign country . . . more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same (the invention) is proved to have been abandoned."

In section 4887, relating to the bearing of a foreign patent granted to an applicant in this country for the same invention, it is provided that a patent shall not be granted in this country upon an application filed more than twelve months subsequent to the filing of the application upon which the foreign patent was granted. The act of the inventor in permitting a foreign patent to issue under such circumstances operates as a virtual abandonment of his invention to the public in this country.

Section 4897, providing for the renewal of a forfeited application by means of a second application, contains the reservation "but such second application must be made within two years after the allowance of the original application," and further "and upon the hearing of renewed applications preferred under this section, abandonment shall be considered as a question of fact."

Section 4920, relating to the pleading in suits for infringement, enumerates among the proofs which may be adduced the fact that the invention had been in public use

or on sale for more than two years before the application for a patent or had been abandoned.

The term abandonment of invention is often somewhat loosely applied to three quite distinct conditions:

First: That situation where the would-be inventor has failed to complete his invention and embody it in an operative device or process useful to the public, and finally, either through discouragement or from pressure of other affairs, lays it aside uncompleted. This is hardly an abandoned invention for, properly speaking, there has been no invention. It is necessary that the inventive act shall be complete and embodied in operative and useful form, otherwise there exists merely an incomplete concept which if cast aside in that condition can be no more than an abandoned experiment or abandoned attempt to make an invention. A patent is essentially a contract between the inventor and the public in which the latter agrees to confer upon the former a monopoly, limited as to time, of the exclusive rights in his invention in consideration of the cession to the public of all such rights at the expiration of the term of the monopoly. If the invention has not been completed it can not serve as a consideration for such a contract and therefore the neglect or inability to complete it can not constitute an abandonment to the public nor serve to deter another from completing it or using it as a basis for other inventions and reaping the rewards of his greater inventive skill or diligence.

Second: That condition where the inventor completes his invention and clothes it in operative and useful form ready for disclosure to the public, and fails to make such disclosure, laying it aside for future development. There seems to be here no idea of abandonment to the public since the latter, under such circumstances, can have no knowledge of the invention nor profit from it. Such withholding of the invention from public knowledge does not prevent another and more diligent inventor from obtaining a patent on the invention so withheld from the public, nor does it prevent the dilatory inventor from later obtaining a patent if the delay in disclosure be excusable or if no other inventors have established rights during the delay.

Third: That condition arising when the inventor has

completed his invention in operative form and then, voluntarily or involuntarily, at any time, either before applying for a patent, at the time of such application or during its prosecution, relinquishes to the public his rights to that invention. This seems to be properly termed abandonment of invention, for the relinquishment is final and irrevocable, the public enters into full possession of the invention so abandoned and any subsequent patent thereto is barred to the inventor or any other person. As Robinson tersely sums up these different classes: "The first abandonment is an abandonment of his intention to become an inventor; and leaves the field open for subsequent inventors to conceive such new ideas or such improvements upon his idea, as will complete the invention and enable them to appropriate it to their exclusive use. The second abandonment is an abandonment of his intention to render the invention practically available for any purpose, and thereupon it is regarded as never having been conceived. The third and true form of abandonment is a dedication of the invention to the public and closes the field forever against not only himself but every subsequent inventor, until the art or instrument shall once more pass from public knowledge and thus become a subject for re-invention."

The surrender of a patent to the public before the expiration of its life seems not to be properly included in the term "abandonment of invention," but rather is a dedication or gift to the public of an item of personal property analogous to the similar gift of any other form of property.

Abandonment of invention may, therefore, be defined as the complete and final relinquishment to the public by the inventor of a complete invention of all his rights thereto. The surrender must be to the public as a whole and not merely to an individual nor to particular individuals and must be before the grant of a patent.

Abandonment of invention, once effected, is irrevocable:

"An inventor may abandon his invention. This inchoate right thus once gone can not be resumed." (Pennock *vs.* Dialogue, 2 Peters, 1.)

Consideration of the subject of abandonment of invention naturally follows two broad lines, those of actual abandonment and of constructive abandonment.

ACTUAL ABANDONMENT OF INVENTION.

Actual abandonment of an invention is effected by the expressed or inferred intention of the inventor to relinquish to the public his entire rights in such invention. He may expressly declare his purpose or his conduct and circumstances may make reasonable the inference that he had such intention to relinquish his rights. The circumstances tending to show such intent on the part of the inventor may and do vary in each case, but the courts look with scant favor upon forfeiture by abandonment of the inventor's rights and the intent to so relinquish must in all cases be clearly and fully established by proof.

WAYS IN WHICH AN INVENTION MAY BE ABANDONED.

An inventor may complete his invention and communicate it to the public, verbally or in writing, and at any time make known his intention to dedicate his invention to the public, waiving any rights to exclusive use by himself; or he may publish his completed invention and then neglect to use it or to seek to patent it, thus showing no intention to retain it for his own use; or he may perfect and use it and then apply for a patent before two years public use has occurred, the public use being accompanied by circumstances which show an intention on his part to relinquish his rights to the public, even though such intention was afterward repented of and an application filed. All the foregoing conditions effect abandonment of the invention, the presumption of abandonment being always strengthened where another inventor has entered the field and established an equity while the first inventor has inexcusably neglected to file an application to protect his rights. What constitutes unreasonable delay is of course a question of fact in each case. A brief outline helpful in such consideration is given in Von Schmidt *vs.* Bowers, 80 O. G., 347:

> Delay in applying for a patent after an invention is made will not constitute abandonment where the inventor has used reasonable diligence to perfect the invention and avail himself of its

> benefits and there is no general standard by which such diligence is to be established; but it must be reasonable under all the circumstances of the particular case. The character of the invention; the health, the means, the liberty of the inventor; his occupation upon kindred or subordinate inventions; are proper subjects for consideration. Such reasonable diligence does not involve uninterrupted effort nor the concentration of his entire energies upon the single enterprise.

A delay of years between the reduction to practice of an invention and application for a patent therefor shown to be for the purpose of first profiting from the use of the invention in secret and then from patent protection was held to constitute abandonment (*In re* Mower, 88 O. G., 191).

Abandonment of invention may be effected by a statement signed by the inventor, filed with or included in an application, dedicating to the public the matter disclosed therein, or any part of it; or the inventor may embody in one application as filed an express declaration of abandonment of an invention disclosed or claimed in another application.

The inventor may fail to claim an invention disclosed in an application containing claims to other features indivisible from such invention. The statutes require that the inventor "shall particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery." If he discloses an invention without any effort to claim it the presumption is that his intention is to dedicate it to the public unless the circumstances are such that he could not claim it in the same application with the invention to which he has directed his claims, or unless he claims it in another contemporaneously pending application.

Abandonment of invention by failure to claim it is discussed in *ex parte* Mullen and Mullen, 50 O. G., 837. In this case the examiner declined to examine a certain application on the ground that it covered matter shown, but not claimed, in an earlier patent granted to the same party prior to the date of the second application. He

held that applicant's only relief lay in a resissue of the earlier patent. The Commissioner, Mr. Mitchell, reversed the examiner and took occasion to say:

> The only relief possible is through the right to obtain a patent upon the latter application for that which was described but not claimed in the earlier application, if such a right is recognized by law and is applicable to this case.
>
> It is believed that applications may be divided into three different classes with reference to that aspect of the question of division which is here involved.
>
> 1. Cases where the various claims differ among themselves only as they constitute different statements of one and the same indivisible invention—cases where, in other words, the lines of division exist as mental figments only and have no corresponding existence in the concrete subject of invention. In all such cases one application only is permissible, whether pending concurrently or not, because only one patent can be granted for a single invention and a second patent for the same invention under another guise would result inevitably in an illegal extension of the period of exclusive use.
>
> 2. Cases where several distinct inventions are dependent upon each other and mutually contribute to a single result. In such cases the several inventions may be included in one patent or they may be separated into as many patents as there are separate and distinct inventions. In all such cases if a patent issues describing all of the mutually dependent inventions and claiming but one of them, a presumption of dedication arises out of the failure to claim what might have been claimed in the same application. This presumption of dedication is repelled, however, if the inventions not claimed in the patent first to issue are claimed in applications contemporaneously pending in the office.
>
> 3. Cases where the invention described and not

> claimed is absolutely independent of the invention actually claimed in the first patent. In such a case the invention described but not claimed could not have been lawfully protected in one patent with the independent subject-matter which was actually secured. There can be no presumption of dedication arising out of a failure to claim in a given application what could not have been claimed in that application and it is believed that no obstacle exists in such a case to obtaining a patent otherwise allowable upon any application that may be filed before the invention has been in public use or on sale for more than two years and before actual abandonment.

It may be remarked that in the class last referred to the second application must be filed not more than two years from the patent date of the first application, else the patent will serve as a publication to bar the grant of a subsequent patent.

An invention may be abandoned by deliberately canceling claims to it from an application in which it is claimed and omitting to file other claims to it, either in the same or another application, before the grant of a patent on the application from which it was canceled. For the purpose of securing a speedy allowance the applicant not infrequently cancels claims which are under rejection on references or for other reasons and obtains a patent with more limited claims than those which he had at some time pending in his application. If he later repents of the cancellation and seeks to secure by a reissue the matter covered by the claims he had eliminated, he finds that he is unable to do so—he has abandoned the invention covered by them; there was no inadvertence, accident or mistake. Closely allied to this situation is that where the applicant inserts in the specification a disclaimer or statement of limitation of the scope of the matter claimed. The final result is equally disastrous, for the scope of the patent granted after such a history will be held strictly within the limits set by the applicant himself. This practice is well established by decisions of the Supreme Court, from which are selected Yale

Lock Co. *vs.* Berkshire Bank, 51 O. G., 1291; Pittsburg Reduction Co. *vs.* Cowles, 55 F. R., 320; Leggett *vs.* Avery, 17 O. G., 445; Union Metallic Cartridge Co. *vs.* United States Cartridge Co., 30 O. G., 771; Shepard *vs.* Carrigan, 34 O. G., 1157; and Roemer *vs.* Peddie, 49 O. G., 2151, the following excerpts being taken from certain of these decisions:

> The proceedings in the Patent Office are for the purpose of reducing the description of the real discovery and the claims to such a form that a patent may properly be granted for them. Until the patentee accepts the patent, he can not be held impliedly to disclaim anything in his real discovery. If he makes a claim which is rejected and he accepts the patent without the claim, then he waives the right to a monopoly therein (Pittsburg Reduction Co. *vs.* Cowles, supra).
>
> If an applicant, in order to get his patent, accepts one with a narrower claim than that contained in his original application, he is bound by it. If dissatisfied with the decision rejecting his application, he should pursue his remedy by appeal. Under the circumstances of this case, the inventor could not even get a reissue based on the broader claim which she has abandoned (Leggett *vs.* Avery). Much less can she, in a suit brought to restrain its infringement, enlarge her patent by argument, so as to cover elements not falling within its terms, and which she had explicitly abandoned (Shepard *vs.* Corrigan, supra).
>
> This court has often held that when a patentee, on the rejection of his application, inserts in his specification in consequence, limitations and restrictions for the purpose of obtaining his patent, he can not, after he has obtained it, claim that it shall be construed as it would have been construed if such limitations and restrictions were not contained in it (Roemer *vs.* Peddie, supra).

Under such rulings the importance of careful consideration by the examiner in requiring cancellations and

limitations and by the applicant in complying with such requirements becomes apparent.

A party having a patent involved in interference may file a reissue therefor leaving out the claims corresponding to the counts of the issue. This has been construed as a formal abandonment of the invention covered by such claims (Lattig & Goodrum *vs.* Dean, 115 O. G., 505).

An invention which forms the subject-matter of an interference may be abandoned under Rule 125 by an unequivocal, unconditional, unlimited, written declaration of abandonment of the invention, signed by the applicant in person and by any assignee. Judgment of priority will then be rendered in favor of the remaining party if there be only one, or the interference will be continued between the remaining parties if there be more than one (Skinner *vs.* Murray, 107 O. G., 542, and Gabrielson *vs.* Felbel, 121 O. G., 691).

If each party involved in interference file such a declaration of abandonment the interference will be dissolved (Krakau *vs.* Harding, 107 O. G., 1662).

A stipulation of the parties to an interference setting forth that the issue is not patentable will be treated as an abandonment, and the interference remanded to the primary examiner with instructions to dissolve it (Lesley & Spackman *vs.* Ellis, 21 Gourick, 35-5).

An application may be abandoned without necessarily abandoning the invention covered by it, unless there be other facts to show conclusively that the inventor, in abandoning his application, intended thereby to abandon the invention also.

Another cause of abandonment after application may be the operation of equitable estoppel. An inventor who completes an invention and inexcusably delays application for its protection by a patent, does so at his own risk, since during the period of his laches another more diligent inventor may apply for and obtain a patent for the invention or intervening rights may arise to deprive the first inventor of the rewards he might have reaped by the exercise of greater diligence. Does this doctrine of equitable estoppel apply to applications filed in the Patent Office and prosecuted within the provisions of its

rules? This question has been treated in a recently published decision of the examiners-in-chief (Barber *vs.* Wood, 207 O. G., 299). Briefly stated, the facts are that while Wood's application was in issue awaiting the payment of the final fee, Barber's patent was inadvertently issued by the office without institution of interference proceedings between these copending applications of Barber and Wood and Barber soon after made machines embodying the invention and placed them on the market, selling a number of them. Wood forfeited his application after Barber's patent had issued and did not renew it until nearly eighteen months after such issuance. The application and patent then went into interference, the final adjudication of which was a decision by the examiners-in-chief awarding priority to Barber on the ground that Wood, through his delay in renewing his forfeited application when other parties had patented the invention and established intervening rights, was equitably estopped from obtaining a patent for the invention he had thus abandoned through his own laches. This conclusion appears to be based upon no proved intention on the part of Wood to abandon his invention, but rather upon the broad equities as disclosed in the record, differing in this respect from the other causes of abandonment previously referred to in this section. This decision should be read in onnection with Cutler *vs.* Leonard, 136 O. G., 438; Cain *vs.* Park, 86 O. G., 797; Mason *vs.* Hepburn, 84 O. G., 147; Crown Cork and Seal Co. *vs.* Aluminum Stopper Co., 96 O. G., 2573; Warner *vs.* Smith, 84 O. G., 311; Christensen *vs.* Noyes, 90 O. G., 223; and Farmer *vs.* Brush, 17 O. G., 150.

CONSTRUCTIVE ABANDONMENT.

Constructive abandonment of invention is effected by the application of statutes which operate entirely regardless of the intention of the inventor with respect to the abandonment of his invention.

The most usual example of constructive abandonment is, perhaps, that due to public use or sale for more than two years prior to application.

The statutes of 1793 provided that abandonment

should ensue in case of any public use of an invention before the inventor had applied for patent therefor. This was interpreted by the courts to mean any public use with the consent or acquiescence of the inventor. In 1836, this interpretation of the courts was adopted in the statutes and at the same time, the sale of the invented thing was made equivalent to its public use. In 1839, in order to alleviate somewhat the hardships imposed upon inventors by so strict a rule, and, possibly, to avoid certain difficulties arising in the consideration of questions of fact relating to consent or acquiescence in different cases, Congress provided by statute that an invention might be used or sold for not over two years before date of application for a patent without abandonment thereby ensuing. In this statute the words "with the consent or allowance of the inventor" were omitted and have not been embodied in any subsequent statute.

The courts in interpreting the statute of 1839 have held that the omission of the clause above quoted was intentional on the part of Congress, and that constructive abandonment is effected when the invention has been in public use or on sale for more than two years prior to the date of application, whether or not such use or sale is known to or acquiesced in by the inventor. The leading decision on this point is the so-called "driven well case," Andrews *vs.* Hovey, 41 O. G., 1162 (Supreme Court).

The tests for determining public use or sale constitute a separate subject for consideration and will not be discussed here.

An invention applied for after 1897, may be constructively abandoned by failure of the inventor to apply for a patent in this country within two years of the issuance of a patent in any country to any person, or within two years after the subject of invention was described in a printed publication anywhere.

Closely allied to this form of constructive abandonment is that occurring under Section 4887, where the inventor of an art, machine, manufacture, or composition of matter, has applied for a foreign patent more than twelve months before the date of application in this country,

and a patent has been granted on such foreign application before the invention has been patented in this country. In the case of designs this period of twelve months is reduced to four months. This form of constructive abandonment applies to all applications filed subsequent to March 3, 1903.

With respect to all applications filed subsequent to 1897, and prior to March 3, 1903, foreign patents granted on applications filed more than seven months prior to application in this country effect constructive abandonment of the invention covered thereby, if the patent in this country be not granted before the issuance of the foreign patent.

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